



PATENT

IBM/02B
Confirmation No. 9272

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Joseph Phillip Bigus et al. Art Unit: 3621
Serial No.: 09/431,833 Examiner: Firmin Backer
Filed: November 2, 1999 Atty. Docket No.: IBM/02B
For: INTELLIGENT AGENT WITH NEGOTIATION CAPABILITY AND
METHOD OF NEGOTIATION THEREWITH

RESPONSE

Mail Stop NON-FEE AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in reply to the Office Action dated June 18, 2003, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, the previous rejection of claims 54-63 and 104-112 under 35 U.S.C. § 102(e), based upon anticipation by U.S. Patent No. 5,550,145 to Hoffman et al.¹ was withdrawn, with the Examiner now rejecting these claims under 35 U.S.C. § 103(a) for obviousness over Hoffman et al. in view of a newly cited reference, U.S. Patent No. 5,905,495 to Tanaka et al.

Applicants continue to traverse the Examiner's rejection.

¹ The specific rejection again refers to U.S. Patent No. 5,550,145 to Hoffman et al. As Applicants pointed out in the previous Response, it appears that the cited patent number for the reference is incorrect, as the number corresponds to a patent for an antimicrobial composition. Moreover, the Examiner's 892 Form from the Office Action mailed December 30, 2002 refers to a U.S. Patent No. 5,613,012 to Hoffman et al., and it is this latter number that Applicants assume is the correct patent number for the reference being cited by the Examiner against the Application. If Applicants' understanding is incorrect, Applicants request that the Examiner note this in the Examiner's next communication.

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As an initial matter, Applicants note that initialed copies of the list of references submitted with two Supplemental Information Disclosure Statements, dated April 16, 2002 and October 24, 2002, have not yet been returned by the Examiner. Copies of these forms have been enclosed for the Examiner's convenience. Applicants respectfully request that the Examiner review the cited references and return initialed copies to Applicants with the Examiner's next communication.

Now turning to the subject Office Action, and in particular to the rejection of claim 54, as noted previously, this claim generally recites a method of identifying an unknown party interacting with an intelligent agent. The method includes determining at least one attribute related to the unknown party, comparing the attribute for the unknown party with attributes related to a plurality of known parties, and identifying the unknown party as the known party having the attribute which most closely matches that of the unknown party.

The Examiner now admits that Hoffman et al. "fail to teach an inventive concept of identifying an unknown party interacting with an intelligent agent." (June 18, 2003 Office Action, ¶4). However, the Examiner now relies on Tanaka et al. for allegedly teaching this concept.

However, like Hoffman et al., Tanaka et al. is completely silent with respect to intelligent agents, so the reference adds absolutely nothing to the rejection.

Intelligent agents, within the context of the invention, are described in detail at pages 3-4 of the application, and may generally be considered to be relatively autonomous computer programs that may also be mobile in nature, e.g., so that they may be communicated and run on remote computers. There is no disclosure in Tanaka et al. that discloses any computer programs that are even arguably analogous to intelligent agents. Indeed, a search of the text of Tanaka et al. fails to find a single reference to an "agent" or "intelligent agent".

What Tanaka et al. does disclose, on the other hand, is a communication system that enables a first party to initiate a direct communication session with a second party, even when the first party does not have the IP address of the second party (e.g., because

the second party is assigned a dynamic IP address that changes every time the second party connects to the Internet). The disclosed process effectively operates by having the first party send an email to the second party, with the IP address of the first party included in the email. Once received, the second party is able to click on an icon to initiate the direct communications session with the first party using the IP address of the first party. Both parties in these instances are presumed to be humans, and Applicants have found no disclosure in the reference suggesting otherwise.

Applicants can find no disclosure or suggestion anywhere in Tanaka et al. relating to intelligent agents. Moreover, it is important to note that Tanaka et al. does not even disclose or suggest any functionality for identifying an unknown party. Instead, all parties in the Tanaka et al. communication system are known (by virtue of the fact that the email address of each party must be known to enable those parties to be contacted via email). The only information that could be argued to be "unknown" is the dynamic IP address of each party; however, the fact that the IP address of a party is unknown does not make the party itself unknown.

To sustain the obviousness rejection of claim 54, the Examiner is required to provide objective evidence of a recognized motivation in the art to modify Hoffman et al. to identify an unknown party interacting with an intelligent agent. The Examiner has failed to meet this burden. Indeed, neither reference has anything to do with intelligent agents, and Tanaka et al. does not even involve identifying unknown parties. The Examiner has therefore failed to raise a *prima facie* case of obviousness.

As such, Applicants submit that claim 54 is non-obvious over the reference, and the rejection should be withdrawn. Moreover, particularly in view of the fact that the current rejection is now the fourth non-final rejection that has been raised against claim 54 (despite the fact that the claim has never been amended), Applicants respectfully request immediate allowance of the claim.

Next, with regard to independent claims 60 and 61, each of these claims likewise recites the identification of an unknown party interacting with an intelligent agent through the comparison of attributes determined for an unknown party with attributes related to a

plurality of known parties. Claims 60 and 61 are therefore non-obvious over Hoffman et al. and Tanaka et al. for the same reasons as presented above for claim 54. Applicants therefore respectfully request reconsideration and allowance of these claims.

Finally, with respect to dependent claims 55-59 and 104- 112, these claims are patentable by virtue of their dependencies on the aforementioned independent claims 54, 60 and 61. However, Applicants also wish to point out that a number of additional features recited in the dependent claims were addressed in Applicants' prior Response, dated March 31, 2003, but were not addressed by the Examiner in the instant Office Action. Applicants will again set forth the arguments presented in the prior Response, and Applicants respectfully request the Examiner's careful consideration of these arguments.

In particular, as with the prior Office Action, the Examiner has again cited the identical passages in Hoffman et al. to reject each and every dependent claim, with the reasons presented in support of such rejections being entirely conclusory in nature. Moreover, no rebuttal to Applicants' prior arguments was provided by the Examiner.

As Applicants argued previously, with regard to claims 57, 104, 105 and 110, which are all directed in part to the use of weighting factors, Applicants can find no teachings in the cited passages that disclose or suggest the use of weighting factors in connection with identifying an unknown party based upon a plurality of attributes.

In addition, with regard to claims 58, 106 and 111, which recite in part that the unknown party is an intelligent agent configured to conduct electronic transactions, Hoffman et al. discloses no functionality that would even arguably be capable of ascertaining the identity of a computer program such as an intelligent agent. Instead, Hoffman et al. is directed to identifying a human unknown party through the use of biometrics, which is defined by Webster as "the statistical study of biological phenomena." Examples of biometric techniques in Hoffman et al. include "finger prints, hand prints, voice prints, retinal images, handwriting samples and the like" (Col. 4, lines 22-24). Biometric analysis is irrelevant for ascertaining the identify of an intelligent agent or any other computer program. As such, Applicants respectfully submit that the

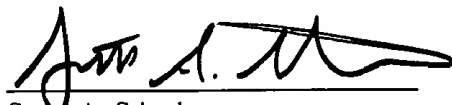
biometric techniques described in Hoffman et al. fall far short of disclosing or suggesting the identification of an intelligent agent configured to conduct electronic transactions, as recited in claims 58, 106 and 111.

Likewise, with respect to claims 59, 107 and 112, these claims recite in part scanning program code for an intelligent agent unknown party to determine attributes thereof. Applicants respectfully submit that Hoffman et al.'s disclosure of a biometric technique for identifying an unknown person does not even arguably suggest the scanning of program code to ascertain the identity of an intelligent agent or other computer program.

Given also that Tanaka et al. does not appear to disclose or suggest any of the aforementioned concepts, and that the Examiner has not even attempted to argue as such, Applicants respectfully submit that the aforementioned dependent claims are non-obvious over the combination of Hoffman et al. and Tanaka et al. Reconsideration and allowance of these claims are therefore respectfully requested.

Applicants therefore respectfully request reconsideration and allowance of all pending claims. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,



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17 SEP 2003
Date

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Att'y Docket No. IBM/02B/124

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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid in an envelope addressed to: Mail Stop NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: September 17, 2003.

Scott A. Stinebruner 17 SEP 2003
 Scott A. Stinebruner Reg. No. 38,323 DATE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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 Commissioner for Patents
 P.O. Box 1450
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AMENDMENT TRANSMITTAL

1. ☒ Transmitted herewith is a Response and copies of Supplemental Information Disclosure Statement Forms submitted by Applicants on April 16, 2002 and October 24, 2002.
2. ☐ Small Entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
☐ Enclosed is a verified statement to establish Small Entity status
☒ Other than a Small Entity

3. The fee has been calculated as shown below:

CALCULATION OF FEES

Fee:	Number of Claims After Amendment:		Previously Paid For:	No. Extra:	At Rate:	Amount:
Total Claims	19	minus	20	0	\$18	\$0.00
Independent Claims	3	minus	3	0	\$84	\$0.00
MULTIPLE DEPENDENT CLAIM FEE					\$280	\$0.00
TOTAL FEE FOR CLAIMS:						\$0.00

☒ No additional fee for claims is required.

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4. ☒ Attached is a check in the sum of \$_____ for additional claims.
☐ Please charge my Deposit Account No. 23-3000 in the amount of \$_____.

5. **The proceedings herein are for a patent application and the provisions of 37 CFR 1.136 apply. Complete (a) or (b) as applicable.**

- ☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

	<u>Ext. Mos.</u>	<u>Large entity</u>	<u>Small entity</u>
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 410.00	\$ 205.00
<input type="checkbox"/>	three months	\$ 930.00	\$ 465.00
<input type="checkbox"/>	four months	\$1,450.00	\$ 725.00
<input type="checkbox"/>	five months	\$1,970.00	\$ 985.00

Extension fee due with this request:

\$_____

Method of Payment:

Check enclosed in the amount of \$_____

If an additional extension of time is required, please consider this a petition therefor.

(Check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured and the fee paid thereof of \$_____ is deducted from the total fee due for the total months of extension now requested. Extension fee due with this request \$_____.

OR

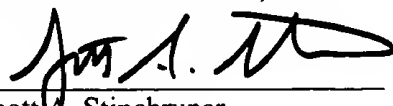
- ☒ (b) **Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.**

6. ☒ **If any additional fee for claims or extension of time is required, charge Account No. 23-3000.**

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By:


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Enclosed:

Transmittal (in duplicate) containing Certificate of Mailing under 37 C.F.R. 1.8
Response

Copies of Supplemental Information Disclosure Statement Forms submitted by Applicants on April 16,
2002 (1 pg.) and October 24, 2002 (2 pgs.)

Reply Postcard